



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

09/696,095

10/25/2000

Mitsuharu Kamiya

00754/LH

3189

1933 7590 06/18/2009
FRISHAUF, HOLTZ, GOODMAN & CHICK, PC
220 Fifth Avenue
16TH Floor
NEW YORK, NY 10001-7708

EXAMINER

CHAMPAGNE, DONALD

ART UNIT

PAPER NUMBER

3688

MAIL DATE

DELIVERY MODE

06/18/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/696,095	Applicant(s) KAMIYA, MITSUHARU	
	Examiner Donald L. Champagne	Art Unit 3688	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 November 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 63, 66 and 69 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 63, 66 and 69 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 October 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>three documents</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Information Disclosure Statement

1. The three IDS documents filed on 19 November 2008 have been considered and made of record herewith. Only one has been signed because the other two are duplicates of that one.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 63, 66 and 69 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The following phrase (e.g., in claim 63, lines 23-27),

“and for storing the received content name and print format information in a reservation information storage means associated with a user identification of the one of the portable information terminals which accesses the apparatus”,

Is indefinite because it is not clear what the term “associated with a user identification” modifies. The phrase is interpreted to mean that it the “reservation information storage means” which is “associated with a user identification”. See para. 6 below.

Claim Rejections - 35 USC § 102 and 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 63, 66 and 69 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eldridge et al. (US006397261B1, hereafter “Eldridge”).

Art Unit: 3688

6. Eldridge teaches (independent claims 63 and 68) a printing information distribution apparatus (*distributed operating environment 100*, col. 3 lines 43-58 and Fig. 1) which is adapted to be operably connected to portable information terminals (*mobile computing devices 118*) and printers (*printer 102*) through a communication network (*networks 116 and 122*), the apparatus comprising:

reception means (*token-enabled server 126 for providing a token to print transaction service*, col. 10 line 42-48) for receiving a content name and print formation information (*respond to a print request ... by recovering a document identified by a selected document token*) transmitted from the one of the portable information terminals (*mobile computing devices 118*) which accesses the apparatus, and for storing the received content name and print format information in a reservation information storage means (*holder device 322*, col. 10 lines 21-22) associated with a user identification (inherently, since *holder device 322* is owned by someone, which reads on “associated with a user identification”) of the one of the portable information terminals which accesses the apparatus; and

generation means for reading the content name and print format information from the reservation information storage means (*holder device 322*), generating a print content based on the read content name and print format information (col. 10 lines 39-50, with *holder device 322* in place of *any mobile computing device 118*).

7. Claim scope is not limited by claim language that suggests or makes optional but does not require steps to be performed, or by claim language that does not limit a claim to a particular structure (MPEP § 2111.04). Accordingly, no patentable weight was given to the following claim language:

“communication means for, when one of the portable information terminals accesses the apparatus, transmitting a content selection screen image and a print format selection screen image to the one of the portable information terminals which accesses the apparatus;” and

“distribution means for, when one of the printers accesses the apparatus, transmitting a user identification input screen image to the one of the printers which accesses the apparatus, receiving a user identification of a portable information terminal transmitted from the one of the printers which accesses the apparatus, and transmitting the print content and print format information corresponding to the received user identification to the one of the printers which accesses the apparatus.”

Art Unit: 3688

8. In addition, the language,

“the print format information comprising at least sheet selection information indicating a type of a printing sheet,”

also was not given patentable weight because it does not limit the claim to a particular structure.

9. Eldridge also teaches claim 69 as the *transaction server 144* (col. 4 lines 48-53, inherently, because a sever cannot work without memory, which reads on a computer readable medium).

10. Eldridge does not teach, transmitting via an electronic mail a print preparation complete notification to the one of the portable information terminals which accesses the apparatus. Because the user of the portable information terminal who ordered the printing would surely like to know that print preparation is complete, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add to the teachings of Eldridge that an email message be transmitted notifying the user of the one of the portable information terminals that print preparation is complete.

11. In addition, under *KSR v. Teleflex* (82 USPQ 2nd 1385), the combination would be obvious because prior art elements are being combined according to known methods to yield predictable results. Eldridge teaches every feature of the claims except notifying the user by email that print preparation is complete. Eldridge does teach notifying the user when the document token is received (col. 10 lines 22-24) and all transmission of document tokens is done by email (col. 7 lines 16-18). Common sense suggests the use of email to notify the user of other milestones, including completion of print preparation.

Response to Arguments

12. Applicant's arguments filed with an amendment on 28 October 2008 have been fully considered and addressed by the revised rejection.

Conclusion

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Art Unit: 3688

14. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.
15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L Champagne whose telephone number is 571-272-6717. The examiner can normally be reached Monday to Wednesday and Friday. The examiner can also be contacted by e-mail at donald.champagne@uspto.gov, and *informal* fax communications (i.e., communications not to be made of record) may be sent directly to the examiner at 571-273-6717.
16. The examiner's supervisor, Eric Stamber, can be reached on 571-272-6724.
17. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).
18. **AFTER FINAL PRACTICE** – Consistent with MPEP § 706.07(f) and 713.09, prosecution generally ends with the final rejection. Examiner will grant an interview after final only when applicant presents compelling evidence that “disposal or clarification for appeal may be accomplished with only nominal further consideration” (MPEP § 713.09). The burden is on applicant to demonstrate this requirement, preferably in no more than 25 words. Amendments are entered after final only when the amendments will clearly simplify issues, or put the case into condition for allowance, clearly and without additional search or more than nominal consideration.

Art Unit: 3688

19. Applicant may have after final arguments considered and amendments entered by filing an RCE.
20. Applicant is advised that, unless a proposed amendment is filed after final and the examiner returns an advisory action with block 3(a) checked (signifying that further search or consideration is required), an amendment filed with an RCE **COULD BE MADE FINAL IN THE FIRST ACTION** in accordance with MPEP § 706.07(b).
21. **ABANDONMENT** – If examiner cannot by telephone verify applicant's intent to continue prosecution, the application is subject to abandonment six months after mailing of the last Office action. The agent, attorney or applicant point of contact is responsible for assuring that the Office has their telephone number. Agents and attorneys may verify their registration information including telephone number at the Office's web site, www.uspto.gov. At the top of the home page, click on Site Index. Then click on Agent & Attorney Roster in the alphabetic list, and search for your registration by your name or number.

17 June 2009

/Donald L. Champagne/
Primary Examiner, Art Unit 3688